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PTO/SB/50 (08-00)

Approved for use through 12/30/2000. OMB 0651-0033

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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REISSUE PATENT APPLICATION TRANSMITTAL

Addressed to: Assistant Commissioner for Patents Box: Reissue Washington, DC 20231	Docket No.	20206-014(PT-TA-410)
	First Named Inventor	COLLINS
	Original Patent No.	5,848,159
	Original Patent Date	December 8, 1998
	Express Mail No.	

APPLICATION FOR REISSUE OF: Utility Patent Design Patent Plant Patent

APPLICATION ELEMENTS (37 CFR 1.173)		ACCOMPANYING APPLICATION PARTS
1. <input checked="" type="checkbox"/> Fee Transmittal Form (PTO/SB/56)		7. <input checked="" type="checkbox"/> Statement of Status/Support for all changes to the claims embedded in the remarks of the preliminary amendment. See 37 CFR 1.173(c).
2. <input type="checkbox"/> Applicant claims small entity status. See CFR 37 1.27.		8. <input type="checkbox"/> Original U.S. Patent for Surrender <input type="checkbox"/> Ribboned Original Patent Grant <input type="checkbox"/> Statement of Loss (PTO/SB/55)
3. <input checked="" type="checkbox"/> Specification and Claims in double column copy of patent format (amended, if appropriate)		9. <input type="checkbox"/> Foreign Priority Claim (35 U.S.C. 119) if applicable
4. <input checked="" type="checkbox"/> Drawing(s) (proposed amendments, if appropriate) <input checked="" type="checkbox"/> Transfer drawings from original patent file		10. <input checked="" type="checkbox"/> Information Disclosure Statement (IDS)/PTO-1449 <input checked="" type="checkbox"/> Copies of IDS Citations
5. <input checked="" type="checkbox"/> Reissue Oath/Declaration (original or copy) (37 C.F.R. § 1.175) (PTO/SB/51 or 52)		11. <input type="checkbox"/> English Translation of Reissue Oath/Declaration
6. Original U.S. Patent currently assigned <input checked="" type="checkbox"/> Yes <input type="checkbox"/> No		12. <input checked="" type="checkbox"/> Preliminary Amendment
<input checked="" type="checkbox"/> Written Consent of all Assignees (PTO/SB/53)		13. <input checked="" type="checkbox"/> Return Receipt Postcard (MPEP 503)
<input checked="" type="checkbox"/> 37 C.F.R. § 3.73(b) Statement (PTO/SB/96)		14. <input checked="" type="checkbox"/> Other: <u>Petition for Waiver under 1.183</u>

15. CORRESPONDENCE ADDRESS

<input checked="" type="checkbox"/> Customer Number <u>25696</u>		or <input checked="" type="checkbox"/> Correspondence address below				
Name	Oppenheimer Wolff & Donnelly LLP					
Address	1400 Page Mill Rd.					
City	Palo Alto	State	California		Zip Code	94303
Country	USA	Telephone	(650) 320-4000		Fax	(650) 320-4100
Name	LEAH SHERRY			Registration No.	43,918	
Signature				Date	10/20/00	

SV/108804.01

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REISSUE APPLICATION FEE TRANSMITTAL FORMDocket Number: 20206-014(PT-TA-410)
Patent: 5,848,159**Claims as Filed – Part 1**

Claims in Patent		Number filed in Reissue Application	(3) Number Extra	Small Entity		Other than Small Entity	
				Rate	Fee	Rate	Fee
(A) 13	Total Claims (37 CFR 1.16(j))	(B) 61	= 48	x\$ _____		x\$18.00	\$864.00
(C) 8	Independent Claims (37CFR 1.16(i))	(D) 20	= 12	x\$ _____		x\$80.00	\$960.00
Basic Fee (37 CFR 1.16(h)) \$710.00						OR	\$_____
Total Filing Fee \$2,534.00							\$_____

Claims as Amended – Part 2

	(1) Claims Remaining After Amendment		(2) Highest Number Previously Paid For	(3) Extra Claims Present	Small Entity		Other than a Small Entity	
					Rate	Fee	Rate	Fee
Total Claims (37 CFR 1.16(j))	13	MINUS	20	*= 0	x\$ _____ =		x\$ 0 =	
Independent Claims (37 CFR 1.16(i))	8	MINUS	8	= 0	x\$ _____ =		x\$ 0 =	
Total Additional Fee						\$0	OR	\$

* If the entry in (D) is less than the entry in (C), Write "0" in column 3.

** If the "Highest Number of Total Claims Previously Paid For" is less than 20, write "20" in this space.

*** After any cancellation of claims.

**** If "A" is greater than 20, use (B-A); if "A" is 20 or less, use (B-20).

***** Highest Number of Independent Claims Previously Paid For" or Number of Independent Claims in Patent (C).

- Applicant claims small entity status. See 37 CFR 1.27.
- Please charge Deposit Account No. 02-3964 in the amount of \$_____.
- A duplicate copy of this sheet is enclosed for this purpose.
- The Commissioner is hereby authorized to charge any additional fees under 37 CFR 1.16 or 1.17 which may be required, or credit any overpayments to Deposit Account No. 02-3964.
- A duplicate copy of this sheet is enclosed for this purpose.
- A check in the amount of \$2,664.00, to cover the filing fee and petition fee under 1.17(h), is enclosed.
- Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038

10/20/00

 Leah Sherry, Registration No. 43,918
 Attorney for Patentee

IN THE UNITED STATES PATENTS AND TRADEMARK OFFICE

Applicant: COLLINS et al.

Attorney Docket No.: 20206-0014(PT-TA-410)

Patent No.: **5,848,159**

Issued: December 8, 1998

For: "PUBLIC KEY CRYPTOGRAPHIC APPARATUS AND METHOD"

JC914 U.S. PRO
09/694416
10/26/00

CERTIFICATE UNDER 37 CFR 3.73(b)

I. Compaq Computer Corporation, a Delaware corporation, certifies that it is the assignee of the entire right, title, and interest in the patent application identified above by virtue of a chain of title from the inventors of the patent application identified above, to the current assignee as shown below:

1. From: Thomas Collins, Dale Hopkins, Susan Langford and Michael Sabin
To: Tandem Computers Incorporated

The document was recorded in the Patent and Trademark Office on May 7, 1997 as Reel and Frame # 8542/0875.

2. From: Tandem Computers Incorporated
To: Compaq Computer Corporation

The document was recorded in the Patent and Trademark Office on October 12, 2000, a copy of which is attached.

The undersigned is empowered to sign this certificate on behalf of the assignee.

Date: 14 OCT 00


Theodore S. Park
Senior Counsel, Intellectual Property

Compaq Computer Corporation
P.O. Box 692000
Houston, TX 7707-2698



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/694,416	10/20/00	Thomas Collins	20206-014 (PT)
PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER	
5,848,159	03/14/01	13	

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

90/ 005,733 Filing Date: 05/18/00
Control No. 90/ 005,776 Filing Date: 07/28/00

Requester Patent Administrator
(name,
address) Testa, Hurwitz & Thibeault, LLP

125 High Street

Boston, MA 02110

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/005733**, filed 05/18/00**, have been considered and the results thereof are reflected in this reissue patent which constitutes the reexamination certificate required by 35 U.S.C. 307 as provided in 37 CFR 1.570(e).

**AND REEXAMINATION REQUEST NO. 90/005,776, FILED ON 07/28/00



UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE
Washington, D.C. 20231

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(mas)

Leah Sherry
OPPENHEIMER, WOLFF & DONNELLY, LLP
1400 Page Mill Avenue
Palo Alto, CA 94304

(For Patent Owner)

Patent Administrator
TESTA, HURWITZ & THIBEAULT, LLP
125 High Street
Boston, MA 02110

(For Requester)

In re Collins et al.
Reexamination Proceeding
Control No. 90/005,733
Filed: May 18, 2000
For: U.S. Patent No. 5,848,159

MAILED

: MAR 14 2001

REEXAM UNIT

In re Collins et al.
Reexamination Proceeding
Control No. 90/005,776
Filed: July 28, 2000
For: U.S. Patent No. 5,848,159

: DECISION TO SUA SPONTE
: MERGE REEXAMINATION AND
: REISSUE PROCEEDINGS

In re reissue application of
Collins et al.
Serial No. 09/694,416
Filed: October 20, 2000
For: U.S. Patent No. 5,848,159

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The above-identified reissue application and reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,848,159 issued to Collins et al. on December 8, 1998.
2. A request for reexamination of the '159 patent was filed by patent owner on May 18, 2000, and the resulting reexamination proceeding was assigned Control No. 90/005,733.
3. On July 19, 2000, reexamination was ordered in the '5733 proceeding.
4. A request for reexamination of the '159 patent was filed by a third party requester on July 28, 2000, and the resulting reexamination proceeding was assigned Control No. 90/005,776.
5. On August 31, 2000, reexamination was ordered in the '5776 proceeding.
6. In the '5733 proceeding, a patent owner's statement under 37 C.F.R. § 1.530 in response to the order was received on September 22, 2000.
7. On October 20, 2000, patent owner filed a reissue application which was assigned Application No. 09/694,416.
8. Notice of the filing of the reissue application was published in the *Official Gazette* on December 5, 2000.
9. On December 6, 2000, a decision merging the '5733 and '5776 reexamination proceedings was mailed.
10. On February 23, 2001, the decision merging the '5733 and '5776 reexamination proceedings was re-mailed.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d) :

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceedings are currently pending. Since the Order has been mailed pursuant to § 1.525 in the `5733 and `5776 reexamination proceedings, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the `5733 reexamination file and the `5776 reexamination file shows that the original specification, drawings and patent claims are presently in the `5733 and `5776 reexamination files. On December 6, 2000, a decision merging these two reexamination proceedings was mailed. On February 23, 2001, the decision merging these two reexamination proceedings was re-mailed. These merged reexamination proceedings are awaiting a first Office action on the merits by the examiner.

A review of the reissue (Application No. 09/694,416) prosecution history shows that the reissue application was published in the Official Gazette on December 5, 2000. The application is awaiting

a first Office action on the merits by the examiner. In addition to amending the specification and patent claims 1-13, in the reissue application, applicant has submitted new claims 14-61 for consideration. Thus, the claims are not identical in all three proceedings. In order to provide efficient and prompt handling of all three proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceedings will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND
REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are sua sponte merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in all three files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in all three cases, specifically, Application No. 09/694,416, and Control Numbers 90/005,733 and 90/005,776. The response to the requirement must be limited to placing the same amendments in all three cases, and patent owner must not address the issues of any of the proceedings in the housekeeping amendment.

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. However, periods of response should be set at two (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).

Each Office action issued by the examiner will take the form of a single action which jointly applies to the reissue application and the reexamination proceedings. Each action will contain identifying data for all three of the cases, i.e., the reissue application and the reexamination proceedings. Each action will be physically entered into all three files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with three copies being filed for entry in the three files, with each of the three copies bearing a signature. Any such responses must be served on the requester, who will also be sent copies of all Office actions. See 37 C.F.R. § 1.550(e).

If the reissue application ultimately matures into a reissue patent, the reexamination proceedings shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved as to the reissue application. With respect to the two reexamination proceedings that will remain merged as one proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express

abandonment, dissolve the merged proceeding as to the reissue application, and continue examination as to the two reexamination proceedings that will remain merged as one proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding as to the reissue application. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 C.F.R. § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding as to the reissue application, a stay of the CPA reissue application, and separate, continued prosecution as to the two reexamination proceedings that will remain merged as one proceeding.

CONCLUSION

1. The above-identified reissue application and reexamination proceedings ARE MERGED into a single consolidated proceeding.
2. The reissue application file and the reexamination files are being forwarded to the Group Director of Technology Center 2100. All further examination should be conducted in accordance with this decision.
3. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in all three cases of the present merged proceeding.
4. The examiner should issue an Office action for the present merged proceeding of the reissue application and

reexamination proceedings after the earlier of:

- (a) the submission of the housekeeping amendment to place the same amendments in all three cases
- (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.

5. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 308-0255.


Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

March 13, 2001